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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,602	03/17/2004	Taketo Itoh	0445-0348PUS1	4176
2292	7590	05/26/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			HILL, LAURA C	
			ART UNIT	PAPER NUMBER

3761

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/801,602

Applicant(s)

ITO ET AL.

Examiner

Laura C. Hill

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-8 is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/17/04 & 9/27/04</u> . | 6) <input type="checkbox"/> Other: ____ |

Art Unit: 3761

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-3 rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (US 5,415,649) in view of Okuda et al. (WO 00/53140A1). Regarding claims 1-3 Watanabe et al. discloses a disposable diaper 1 with absorbent member 4 interposed between liquid permeable topsheet 2 and liquid impermeable backsheet 3, a pair of longitudinal side and end portions (col. 4, ll. 1-6);

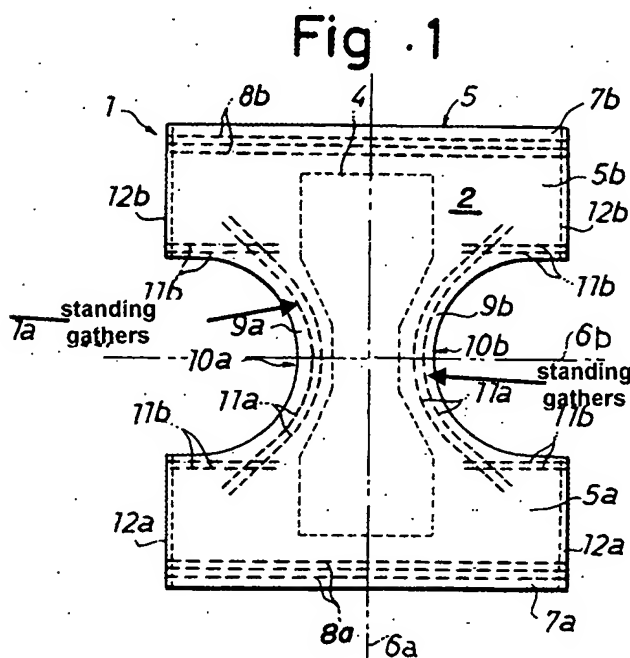
Elastic members 8a, 8b forming a gather/laterally extensible side part on each waist flap 7a and 7b (col. 4, ll. 7-13);

Standing gathers (denoted by arrows in figure 1) having elastic members 11a and 11b having a fixing/stretching ratio of 150% (figure 1 and col. 4, ll. 64-68);

Standing gathers having a tensile load required to extend the standing gathers of 70-100gf, rate of increase of less than equal to 1 gf% [ie: an expanding stress of 10-120

Art Unit: 3761

g in a 20% stretched state, 20-150g in a 50% stretched state and 30-300g in a 100% stretched state] (col. 7, ll. 18-29). Watanabe et al. further discloses increasing fastening force and expansion of whole side panels 62, 63 for preventing a slip-down of the diaper and enhancing the fitness (col. 2, ll. 36-43). Watanabe et al. does not expressly disclose a fastening tape on each side edge or low and high stiffness regions.



Okuda et al. discloses disposable diaper 1 with free end region 64 having a larger stress in the crotch portion of the wearer so that the standing property of the upstanding guard/standing gather 6 improves the fit to prevent leakage caused by crossing over of upstanding guard/standing gather 6 (page 7, ll. 25-29). Okuda et al. further discloses fastening tape 11 on each side edge (page 3, ll. 5-7). Okuda et al. further discloses stress of the upstanding guard elastic member 64 disposed at the longitudinal free edge end/high stiffness region 63 of 10-1000gf and preferably greater

Art Unit: 3761

by from 5-500 gf than that of all the remaining upstanding guard elastic members 64 in a low stiffness region or any region outside of high stiffness region 63 (page 14, ll. 10-12 and fig 1). Okuda et al. further discloses fixed elastic members 64a-64d with a stress of 5-50cN in a 100% stretched condition/fixed extension ratio (page 4, ll. 9-10, page 5, ll. 13-15). Okuda et al. does not expressly disclose a tensile load required to extend standing gathers 6 or the rate of increase. It would be obvious to one of ordinary skill in the art at the time the invention was made to combine the extensible side part 8a, fixing/stretching ratio of 150%, tensile load and rate of increase of Watanabe et al. with the low and high stiffness regions of Okuda et al. to obtain the claimed structure since both reference disclose disposable diapers with leg elastic members for improved article fit about a wearer during use.

2. Claims 4-5 rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (US 5,415,649) in view of Okuda et al. (WO 00/53140A1) as applied to claim 1 in further view of St. Louis et al. (US 5,993,433). Watanabe/Okuda et al. disclose the disposable diaper discussed in rejected claim 1 but do not expressly disclose not expressly disclose a crotch section width. St. Louis et al. discloses disposable diaper 10 with gusset-flap members/standing gathers 19, a fastening system 40, elastomeric members 138 in leg gusset/stiffness region with composite tension of more than 50gf in a 90% stretched condition, and a crotch width 31 of less than 160 mm (col. 3, ll. 45-52, col. 4, ll. 14-17, col. 5, ll. 59-65, col. 18, ll. 9-14, figure 1). St. Louis et al. further discloses the various aspects and configurations of the invention can provide body conformity, reduced bunching between user's legs and improved leakage

Art Unit: 3761

protection (col. 6, ll. 18-22). It would be obvious to one of ordinary skill in the art at the time the invention was made to combine the disposable diaper with standing gathers of Watanabe/Okuda et al. references with the crotch width of St. Louis et al. since all three references disclose disposable diapers with leg elasticized members for improved fit and leakage prevention.

Allowable Subject Matter

3. Claims 6-8 allowed.

The following is a statement of reasons for the indication of allowable subject matter: the art of record fails to anticipate or obviate a diaper with a distance between a pair of fixed ends and a pair of standing gathers measured at the smallest width of a crotch section, a ratio of aforementioned distance to a distance between each elastic member arranged outward in each leg gather, and a distance between each of the fixed ends of a pair of standing gathers smaller than a width of the standing gathers on each side as measured at the smallest width of the crotch section.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

Art Unit: 3761

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 6-8 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3, 5, 7, 8, and 9 of copending Application No. 10/626,547. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications contain disposable diapers with fastening members with a pair of standing gathers having tensile characteristics and a low stiffness region.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101, which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re*

Art Unit: 3761

Ockert, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Clear et al. reference, US patent no. 5,368,584, is cited for showing an absorbent diaper with thigh panel extension portion rates but thigh panel does not expressly disclose not contain elasticized standing leg gathers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C. Hill whose telephone number is 571-272-7137. The examiner can normally be reached on Monday through Friday (off every other Friday).

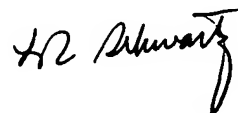
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on 571-272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3761

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Laura C. Hill
Examiner
Art Unit 3761

LCH



Larry I. Schwartz
Supervisory Patent Examiner
Group 3700